

[counsel listed on signature page]

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

ORACLE AMERICA, INC.

Plaintiff,

v.

GOOGLE INC.

Defendant.

CASE NO. CV 10-03561 WHA (DMR)

**STIPULATION AND [PROPOSED]
ORDER REGARDING ORACLE
AMERICA, INC.'S FIRST
AFFIRMATIVE DEFENSE –
ASSIGNOR ESTOPPEL**

Judge: Honorable William H. Alsup

STIPULATION

WHEREAS, Oracle in its Amended Complaint alleged that “Android (including without limitation the Dalvik VM and the Android software development kit) and devices that operate Android infringe one or more claims of each of United States Patents Nos. 6,125,447; 6,192,476; 5,966,702; 7,426,720; RE38,104; 6,910,205” (Dkt. No. 36);

WHEREAS, Google in its Answer to Oracle’s Amended Complaint and Amended Counterclaims alleged the invalidity of the seven patents-in-suit (Dkt. No. 51);

WHEREAS, Oracle in its Answer to Google’s Amended Counterclaims alleged that the doctrine of assignor estoppel barred Google’s assertion of invalidity based on Google’s employment of and being in privity with some of the inventors of the seven patents-in-suit (Dkt. No. 60);

WHEREAS, Google filed a précis letter seeking leave of the Court to file a motion for partial summary judgment on Oracle America, Inc.’s First Affirmative Defense of assignor estoppel (Dkt. No. 309);

WHEREAS, evidence obtained in discovery taken to date shows that Google employs or has employed James Gosling, named inventor of U.S. Reissue Patent No. RE38,104; Frank Yellin, a named inventor of U.S. Patent No. 6,061,520; and Lars Bak and Robert Greisemer, named inventors of U.S. Patent No. 6,910,205;

WHEREAS, based on evidence obtained in discovery taken to date, it appears that none of James Gosling, Frank Yellin, Lars Bak, and Robert Greisemer are an executive, officer, or substantial shareholder of Google and that none provided substantial “knowledge and assistance to develop any aspects of the accused Dalvik Virtual Machine or of the Android SDK that allegedly infringe the patents that those inventors assigned to Sun,” as Google wrote in its précis letter;

WHEREAS, Google argued in its précis letter that “[a]ssignor estoppel would be appropriate only if Google’s alleged infringement depended upon the engineers’ knowledge and assistance;”

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2 WHEREAS, the Court granted Google leave to file a motion for partial summary
3 judgment on plaintiff's affirmative defense of assignor estoppel, but also noted that "Plaintiff's
4 counsel remain free to negotiate a stipulated resolution of this issue." (Dkt. No. 325.)

5 **NOW THEREFORE THE PARTIES HEREBY STIPULATE AND AGREE** that:

6 1. Oracle's First Affirmative Defense (Assignor Estoppel) as against Google Inc.
7 shall be dismissed with prejudice.

8 **ORDER**

9 The foregoing stipulation is approved, and IT IS SO ORDERED.
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13 Date: _____

14 Honorable William H. Alsup
Judge of the United States District Court
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Dated: September 2, 2011

MORRISON & FOERSTER LLP

By: /s/ Marc David Peters

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ATTESTATION

I, Matthias Kamber, am the ECF User whose ID and password are being used to file this STIPULATION AND [PROPOSED] ORDER REGARDING ORACLE AMERICA, INC.'S FIRST AFFIRMATIVE DEFENSE – ASSIGNOR ESTOPPEL. In compliance with General Order 45, X.B., I hereby attest that Marc David Peters and Matthias Kamber have concurred in this filing.

Date: September 2, 2011

/s/ Matthias Kamber